



PATENT APPLICATION
Doc. No. 7060-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Stanley C. Johnson Conf. No. 1478
Serial No.: 09/903,795 Art Unit.: 1745
Filed: July 11, 2001 Examiner: Jane J. Rhee
For: WOOD PRODUCT HAVING A COMPOSITE SUBSTRATE
COVERED WITH PAPER

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

Enclosed for filing in the above-referenced application are the following:

- ☒ Appellant's Brief (in support of appeal) under 35 CFR § 41.37 is enclosed in triplicate with Exhibit 1 (7 pages).
- ☒ PTO Form 2038 authorizing credit card payment of \$250.00 under 41.20(b)(2) is enclosed.
- ☒ Any deficiency or overpayment should be charged or credited to deposit account number 13-1703.

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Respectfully submitted,

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22313-1450
Date: October 3, 2005

Adrienne Chocholak
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AF
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**APPELLANT'S BRIEF
UNDER 37 CFR §41.37**

Appeal is taken from the Examiner's Office Action mailed May 2, 2005 finally
rejecting claims 24-43 in this application.

This Appeal Brief is in furtherance of the Notice of Appeal mailed in this case on
August 2, 2005.

The fees required under §41.20(b)(1) are dealt with in the accompanying
TRANSMITTAL OF APPEAL BRIEF.

This Brief is transmitted in triplicate.

This Brief contains these items under the following headings, and in the order set
forth below.

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I. REAL PARTY IN INTEREST

37 CFR §41.37(c)(1)(i)

Pacific Wood Laminates, Inc. (“Pacific Wood Laminates”) is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

37 CFR §41.37(c)(1)(ii)

None.

III. STATUS OF CLAIMS

37 CFR §41.37(c)(1)(iii)

Status of All the Claims:

1. Claims presented: 1-43
2. Claims withdrawn from consideration but not cancelled: 9-23
3. Claims canceled: 1-8
4. Claims pending: 24-43

of which:

- a. Claims allowed: NONE
- b. Claims rejected: 24-43

All the rejected claims, namely claims 24-43, are being appealed. The appealed claims are eligible for appeal, having been finally rejected.

IV. STATUS OF AMENDMENTS

37 CFR §41.37(c)(1)(iv)

There have been no amendments filed subsequent to the final rejection.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER
37 CFR §41.37(c)(1)(v)

The present invention relates to a composite wood product used for certain applications in the residential and commercial building industries, and more particularly as a fascia, trim, siding, or wall covering product for exterior use. *See* Specification, p. 1, lines 8-10. The present embodiment includes three primary components, namely laminated veneer lumber, treated paper, and adhesive. *See* Specification, p. 2, lines 25-26.

As is shown in exemplary claim 24, a wood product for use as exterior trim comprises an elongate composite substrate (*see, for e.g.*, Specification, p. 3, line 9), a core defining the interior of the substrate (*see, for e.g.*, Specification, p. 3, lines 13-15), an elongate front surface and an elongate rear surface (*see, for e.g.*, Specification, p. 3, lines 8-11). A pair of opposing edge surfaces extends between the front and rear surfaces, exposing the core on the edge surfaces. *See for e.g.* fig. 3, ref. 40. Treated paper substantially covers and adheres to the front, side, and a portion of the rear surface adjacent to at least one edge surface, such that the covered portion is substantially all of the trim that is visible when installed. (*See, for e.g.*, Specification, p. 5, lines 12-16). A resin is formed on at least the exposed surface and an adhesive is spread between substantially all of the paper and substrate. (*See, for e.g.*, Specification, p. 3, line 23, and Specification, p. 5, lines 1-3).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
37 CFR §41.37(c)(1)(vi)

- A. The Examiner rejected claims 24-35 and 37-42 as obvious over U.S. Patent No. 5,234,519 to Talbot (“Talbot) in view of U.S. Patent No. 4,844,763 to Robbins (“Robbins) and in further view of U.S. Patent No. 5,071,688 (“Hoffman) under 35 U.S.C. 103(a).

B. The Examiner rejected claims 36 and 43 as obvious over Talbot in view of Robbins and Hoffman and in further view of U.S. Patent No. 5,569,505 to Nichols (“Nichols”) under 35 U.S.C. 103(a).

For the convenience of the Honorable Board of Appeals, the entire Final Rejection dated May 2, 2005, has been reproduced and is attached as Exhibit “1”.

VII. ARGUMENT

37 CFR §41.37(c)(1)(vii)

I. Procedural History

In an Office Action dated June 25, 2002, the Examiner entered a restriction requirement, setting forth three different inventions, which the Examiner indicated were unrelated. The first invention included claims 1-8, the second claims 9-15 and the third claims 16-23. Appellant elected to proceed with claims 1-8 and withdrew the remaining claims. In the August 21, 2002 Office Action, the Examiner rejected claims 1, 2, and 4-8 under 35 U.S.C. 102(b) to U.S. Patent No. 3,629,033 to Carter and claim 3 under 35 U.S.C. 103(a) as obvious over Carter in view of U.S. Patent No. 6,364,236 to Podosek. In response, on November 12, 2002, Appellant filed an amendment cancelling claims 1-8 and including new claims 24-34. The February 11, 2003 Office Action finally rejected claims 24-34 as obvious under 35 U.S.C. 103(a) over Talbot in view of Hoffman.

Appellant requested continuing examination on November 4, 2003, including previously presented claims 24-34 and new claims 35-43. On January 27, 2004, the Examiner entered an Office Action rejecting claims 24-43. Appellant amended independent claims 24 and 37, and on May 2, 2005 the Examiner responded by finally rejecting claims 24-43 under the same grounds identified in the January 27, 2004 Office Action. Appellant now appeals that final rejection.

II. Rejections Under 35 U.S.C. §103(a)

A. Rejection of Claims 24-35 and 37-42 Over Talbot in View of Robbins and in Further View of Hoffman.

Insofar as claims 24-35 and 37-42 have been rejected under the same grounds, Appellant argues the claims as a group, and the claims stand or fall as a group. The arguments below are made with respect to claim 24 on behalf of the group.

1. *The Examiner Has Not Made a Prima Facie Case for Obviousness*

To make a *prima facie* case for obviousness, the Examiner must identify some suggestion or motivation to make the combination of references, there must be a reasonable expectation of success, and the combination must teach all of the claim limitations. *See* MPEP 2143. The Examiner has failed to meet her burden as to each of these requirements.

The incentive to combine references must be readily apparent. If the incentive to combine is not readily apparent, the Examiner must explain why the combination of teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788, 1790 (B. App. & Int’f 1986). The Examiner, in making the combination, asserted that Talbot discloses the majority of the claimed elements of claims 24-35 and 37-42. *See* January 27, 2004 Office Action, page 3.¹ The Examiner acknowledged that while Talbot fails to disclose a treated paper covering the surfaces of the trim product, “Robbins teaches that paper may be substituted for the surface veneer sheet or may be adhesively bonded to the exposed surfaces of the wood veneer sheets **for the purpose of providing improved dimensional stability of laminated veneer lumber . . .**” *Id.*, page 4. [Emphasis added].

According to the Examiner, it would have been obvious to one having ordinary skill in the art at the time of applicant’s invention to provide Talbot with a treated paper to improve dimensional stability of laminated veneer lumber. *See* January 27, 2004 Office Action, page 4. However, the asserted motivation to combine cannot be found in the nature

¹ The Examiner’s final Office Action, dated May 2, 2005, relies on the rejections from the January 27, 2004 Office Action.

of the problem, which is identified as improving the durability and appearance of the edges of the trim product. *See* Specification, page 1.

As explained by Appellant's declaratory evidence, rigidity in the edge surface, i.e. dimensional stability, caused cracking in the edge coating and was considered a failure during Appellant's research and development of the inventions the subject of this appeal. *See* DECLARATION OF STANLEY C. JOHNSON ("JOHNSON DEC.") mailed November 4, 2003, paragraph 12. Moreover, it is unlikely that the addition of paper would help to achieve dimensional stability. Thus, a motivation to combine that is at odds with the problem an applicant seeks to resolve, and in this case actually teaches away from the problem, is no motivation at all, and simply reflects hindsight vision on the part of the Examiner. *See* MPEP 2141, 2143. "Obviousness cannot be established by hindsight combination to produce the claimed invention." *In re Dance*, 160 F.3d 1339, 133, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998).

In addition to the failure of motivation, there is no reasonable expectation of success and the combination fails to disclose all of the limitations of the claims. The Examiner has acknowledged that Robbins does not disclose the use of a treated paper to cover the surface of the trim product. *See* January 27, 2004 Office Action, page 4. To make up for this, the Examiner looked to Hoffman. *See id.* However, the portion cited by the Examiner, specifically col. 2, lines 7-9, is describing a prior art process where a resin, in the absence of paper, is applied to a selection of Douglas fir plies to form a substrate.

To address the shortcomings of the portion cited by the Examiner, Hoffman describes a plywood substrate with the appearance side being covered by a medium density fiber overlay, with the edges being characterized by sanded surfaces formed by applying a void filler putty and post filler sanding. *See* Hoffman, col. 2, lines 54-58. Because references

must be considered as a whole, Hoffman, in combination with Talbot and Robbins teaches away from Appellant's invention.

In particular, the combination of Talbot, Robbins and Hoffman discloses a substrate, covered with paper on the appearance side, with the edge sides being coated with putty and sanded to give the appearance of wood. Because Robbins discloses engineered panels, rather than trim work, there is no suggestion or teaching in Robbins that the side edges are covered with veneer. For example: "[i]t is an object of the present invention to provide a panel and laminated veneer lumber having face and back veneer sheets and a mat of adhesively-bonded biomass particles" Thus, the suggestion that a "paper, ornamental wood or plastic sheet may be substituted for the surface veneer sheet or may be adhesively bonded to the exposed surfaces of the wood veneer sheets" necessarily only relates to the face and back of the engineered product, as those are the only portions that have been veneered, and thus may be substituted with paper. *See* col. 7, lines 15-19.

The result of course is that given the limitations of Robbins, which relates to panels rather than trim, because Hoffman alone discloses the use of a medium density fiber overlay, the addition of Robbins adds nothing to the obviousness analysis. However, whether the combination is Talbot/Robbins/Hoffman or Talbot/Hoffman, or perhaps even Hoffman alone, the fact remains that none of the combinations disclose treated paper substantially covering and adhered to all of the front surface, the side surfaces, and at least a portion of the rear surface adjacent at least one of the edge surfaces, the covered portion being substantially all of the trim that is visible when the trim is installed on the building, and a resin treatment formed on at least the exposed surface of the paper. As a result, the combination fails to teach all of the claim limitations, and further fails to provide a reasonable expectation of success, insofar as it only describes the prior art.

2. It Would Not Have Been Obvious to Combine the References

a. Delay Cuts Against Obviousness

The teachings of Robbins, Hoffman and Talbot have been known collectively since 1993, when the last of these contemporaneous references published as patents. Yet, in the eight year period leading up to Appellant's invention, no person of ordinary skill in the art stepped forward to make the combination and produce a product combining the features the Examiner claims to have identified in the combination.

b. Objective Factors of Non-Obviousness Weigh Against Obviousness

An applicant can also establish a case for non-obviousness through objective factors of non-obviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). The relevant objective factors presented by the present application are commercial success, long-felt need, failure of others, and copying. Each will be addressed in turn.

(i) Commercial Success

Appellant has produced both documentary and declaratory evidence that the product disclosed in the present application has enjoyed much more recent commercial success than has the earlier product, which is substantially similar to the Hoffman product.² In particular, the new product (disclosed in the present application) is "uniformly straight, smooth, and true. *See* DECLARATION OF KEN CAYLOR ("CAYLOR DECL."), submitted November 4, 2003, ¶ 2. Existing customers of Pacific Wood Laminates choose the new product over the earlier product, even when offered a discount for the earlier product, will not purchase the earlier product for resale, and find the new product superior. *See id.*, at ¶3. New customers of Pacific Wood Laminates also choose the new product over the Hoffman-type product, and wholesale customers have made sales of the new product to retail customers who would not purchase the earlier product. *See* CAYLOR DECL., at ¶4. Even before the new product was available, verbal descriptions of the new product were met with enthusiasm, when compared with the problems of the Hoffman-type product. *See id.* at Exhibit A. Customers of Pacific

² Declarant Stanley C. Johnson has reviewed U.S. Patent No. 5,071,688 and has declared that the product described therein is the same approach used in Appellant's earlier product, described here as the "earlier product" or the "Hoffman-like product." *See* DECLARATION OF STANLEY C. JOHNSON, ¶3.

Wood Laminates are likewise finding that their own retail customers prefer the new product to the earlier product, despite an abundance of inventory of the earlier product. *See* DECLARATION OF BILL SANREGRET (“SANREGRET DECL.”), submitted November 4, 2003, ¶¶ 2-5.

(ii) Long-felt but unsolved needs

As can be seen, there have been many attempts to provide an engineered wood product capable of withstanding the elements and having the appearance of wood, including the many references cited by the Examiner during the course of prosecution of the present application. The applied references make clear that there is a need in the construction industry for inexpensive, durable, paintable, weatherable, laminated veneer lumber. *See* Robbins, col. 2, line 65 through col. 3, line 2; Hoffman, col. 2, lines 25-35; and Specification, pages 1 and 2.

Although Hoffman stated that it solved the need for such a product, customer experience has proven otherwise. *See* Hoffman, col. 2, lines 25-35. Appellant has been making a product similar to that described by Hoffman since 1994/1995. *See* JOHNSON DECL., ¶¶ 3, 8. Other than Appellant, only one other company has been making a laminated veneer lumber with a paper face and sanded and filled edge, as disclosed in the Hoffman patent. *See id.* at ¶ 3. Since the onset of its manufacture of this Hoffman-type product, Appellant has received annually a barrage of complaints about installed Hoffman-type product, at the pace of more than one such complaint per week. The typical complaints involve a perception of glue line delamination, which in reality are caused by swollen edges and split veneers. Appellant has been resolving these complaints in several different ways, including the Technical Note submitted with STANLEY JOHNSON’S AMENDED DECLARATION, submitted November 4, 2003. In addition to providing the Technical Note and epoxy repair kits, Appellant has been paying to settle claims since approximately 1994. *See* JOHNSON DECL., ¶ 6-8.

Demonstrative evidence, attached as Exhibits B and C to the JOHNSON DECL. depict the degradation problems associated with the Hoffman-type product, with Exhibits D and E depicting the same weather exposure to product constructed in accordance with the inventions disclosed in the present application.

The problems with the prior art product, the desire for an improved product in the construction and lumber industries as evidenced by the prior art patents, and the success of Appellant's new product all support the long-felt need that has been satisfied through Appellant's new product disclosed in the present application.

(iii) Failure of others

As previously discussed, the last of the references from the Examiner's combination was published as a patent in 1993, yet it was not until Appellant's product that a treated paper wrapped, LVL product was developed. The Johnson Declaration sets forth a series of trials beginning in 1995 of Pacific Wood Laminates' efforts to engineer such a product. What is of particular note about those trials is that they were conducted with other companies doing business in the same and related areas of endeavor. Despite the many attempts, it was not until the technology disclosed in the present application, that resolution was had. *See* JOHNSON DECL., ¶¶ 12-17. Thus, not only do the cited portions reflect the extensive effort and investment made by Pacific Wood Laminates, but they also reflect the combined efforts of other related companies to solve the problem.

Because the teachings of the combined references would have been available to those skilled in the art as of their publications, it can be inferred that despite knowledge of these references no one of ordinary skill in the art was able to devise a product that addressed the problems of the prior art products, including cracking, glue line delamination, swollen edges, and split veneers. *See* JOHNSON DECL., ¶ 6.

(iv) Copying

Appellant has provided evidence, by way of the Johnson Declaration that competitors have begun copying Appellant's product. In particular, a company called Veneer Profiles, based in White City, Oregon, has made an LVL product with resin treated paper wrapped on three sides and glued to the LVL substrate with polyurethane hot melt glue. *See* Johnson Dec., ¶18. Photographs of the copy are attached as Exhibit F to the JOHNSON DECL. This type of copying is yet another example of why the present application is allowable.

3. The Examiner's Rejection of Declaratory Evidence was Unreasonable

According to the Examiner, the Johnson, Caylor, and Sangret Declarations are insufficient to overcome the rejection of claims 24-43 because they state that the claimed subject matter solved a problem that was long-standing in the art. *See* May 2, 2005, Office Action, pages 3 and 4. Additionally, the Examiner said there is no showing that others of ordinary skill in the art were working on the problem and, if so, for how long. *See id.* Finally, the Examiner said that there is no evidence that if persons skilled in the art who were working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem.

As an initial point, Appellant notes that the Declarations support much more than long-felt need. In particular, as described above, they also support other objective factors of non-obviousness, such as commercial success, failure of others, and copying. As such, it is improper to discount the Declarations solely on the basis of one objective factor.

As to the issue of the length of time of the long-felt need, Appellant has already established that there was an eight year interval between the publication of the last of the cited references before Appellant's product was introduced and the present application filed. In that time, while it must be presumed that those of skill in the art were aware of the patents, or at least on notice of them, not one such person stepped forward to make the "obvious" combination. Additionally, Declarant Johnson indicated that since approximately 1994

Appellant has been receiving complaints, and even lawsuits, as a result of consumer dissatisfaction with the type of product described by the combination of the references. *See* JOHNSON DECL., ¶¶ 6-8.

B. Rejection of Claims 36 and 43 Over Talbot in View of Robbins and Hoffman and in Further View of Nichols.


Because this second ground of rejection applies to two dependent claims of the group previously discussed, Appellant believes claims 36 and 43 are allowable as claims depending from allowable claims. Moreover, the arguments described above with respect to the remaining claims support the allowability of claims 36 and 43.

CONCLUSION

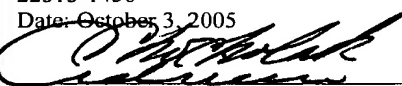
For the foregoing reasons, which include the Examiner's failure to establish a *prima facie* case of obviousness, Appellant requests that the Board reverse the Examiner's rejections to Appellant's claims.

Customer No. 20575

Respectfully submitted,
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
Date: October 3, 2005

Adrienne Chocholak

APPENDIX
37 CFR §41.37(c) (viii)

The text of the claims on appeal is:

Claims 24-43, as follows:

24. A wood product for use as exterior trim on the exterior of a building comprising:
- an elongate composite substrate;
 - a core defining the interior of said substrate;
 - an elongate front surface formed on one side of said substrate;
 - an elongate rear surface formed on the other side of said substrate;
 - a pair of opposing edge surfaces extending between said front and rear surfaces, said core being exposed on said edge surfaces;
 - treated paper substantially covering and adhered to all of said front surface, said side surfaces, and at least a portion of said rear surface adjacent at least one of said edge surfaces, said covered portion being substantially all of said trim that is visible when said trim is installed on the building;
 - a resin treatment formed on at least the exposed surface of said paper; and
 - adhesive spread between substantially all of said paper and said substrate.
25. The wood product of claim 24 wherein said trim is fixedly mounted on said building.
26. The wood product of claim 25 wherein said rear surface includes a mounting surface that flushly abuts the building when said trim is mounted thereon.
27. The wood product of claim 24 wherein said substrate comprises an engineered wood product.
28. The wood product of claim 27 wherein said engineered wood product comprises laminated veneer lumber and wherein said front surface comprises a surface on an outer veneer of said substrate and said edge surfaces comprise edges of veneer layers in said laminated veneer lumber.

29. The wood product of claim 28 wherein said laminated veneer lumber comprises plywood.

30. The wood product of claim 27 wherein said engineered wood product comprises fiberboard and wherein said front surface comprises a top surface of said fiberboard and said edge surface comprises an edge of said fiberboard.

31. The wood product of claim 24 wherein said substrate has a substantially rectangular cross section.

32. The wood product of claim 31 wherein said paper covers a portion of said rear surface adjacent both of said edge surfaces.

33. The wood product of claim 24 wherein said wood product comprises siding.

34. The wood product of claim 24 wherein said wood product comprises fascia.

35. The wood product of claim 24 wherein at least one of said edge surfaces is substantially planar.

36. The wood product of claim 24 wherein at least one of said edge surfaces is substantially nonplanar.

37. A wood product for use as exterior trim fixedly mounted on the exterior of a building comprising:

an elongate composite substrate having a rectangular cross section;

a core defining the interior of said substrate;

an elongate front surface formed on one side of said substrate;

an elongate rear surface formed on the other side of said substrate, said rear surface including a mounting surface when said trim is mounted thereon;

a pair of opposing edge surfaces extending between said front and rear surfaces, said core being exposed on said edge surfaces, wherein said substrate comprises laminated veneer lumber, said front surface comprising a surface on an outer veneer of said substrate and said edge surfaces comprising edges of veneer layers in said laminated veneer lumber;

treated paper substantially covering and adhered to all of said front surface and said side surfaces, said covered portion being substantially all of said trim that is visible when said trim is installed on the building;

a resin treatment formed on at least the exposed surface of said paper; and
adhesive spread between substantially all of said paper and said substrate.

38. The wood product of claim 37 wherein said treated paper further substantially covers and adheres to at least a portion of said rear surface adjacent both of said edge surfaces.

39. The wood product of claim 37 wherein said laminated veneer lumber comprises plywood.

40. The wood product of claim 37 wherein said wood product comprises siding.

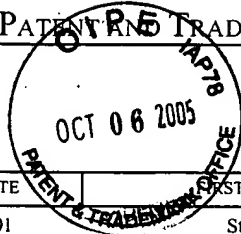
41. The wood product of claim 37 wherein said wood product comprises fascia.

42. The wood product of claim 37 wherein at least one of said edge surfaces is substantially planar.

43. The wood product of claim 37 wherein at least one of said edge surfaces is substantially nonplanar.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,795	07/11/2001	Stanley C. Johnson	7060-3	1478

7590 05/02/2005
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EXAMINER

RHEE, JANE J

ART UNIT PAPER NUMBER

1745

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

09/903,795

Applicant(s)

JOHNSON, STANLEY C.

Examiner

Jane Rhee

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Rejections Repeated

1. The 35 U.S.C. 103(a) rejection of claims 24-35,37-42 over Talbot in view of Robbins and in further view of Hoffman has been repeated for the reasons previously made in office action 1/27/2004.

As to the new limitation, "wood product for use as exterior trim on the exterior of a building" is an intended use. It has been held that a recitation with respect to the manner in which the claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

2. The 35 U.S.C. 103(a) rejection of claims 36 and 43 over Talbot et al. in view of Robbins and Hoffman and in further view of Nichols has been repeated for the reasons previously made in office action 1/27/2004.

Response to Arguments

3. Applicant's arguments filed 10/27/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the Talbot et al. reference is a trim piece for interior applications and are unsuitable for exterior applications and that applicant's wood product is for use as exterior trim on the exterior of a building is a statement of an intended use. It has been held that a recitation with respect to the manner in which the claimed article is intended to be employed does not differentiate the claimed article from

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a prior art article satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Talbot et al. teaches veneer profile wrapping over a substrate (figure 1) and Robbins teaches that paper may be substituted for the surface veneer sheet or may be adhesively bonded to the exposed surfaces of the wood veneer sheets (col. 7 lines 15-19) for the purpose of providing improved dimensional stability of laminated veneer lumber that can be made on conventional apparatus at a commercially acceptable production rate (col. 2 lines 65- col. 3 lines 1-2).

Response to Declaration

4. The Johnson declaration under 37 CFR 1.132 filed 11/7/03 is insufficient to overcome the rejection of claims 24-43 based upon U.S.C. 103 rejection as set forth in the last Office action because: It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on

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the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

The Caylor declaration under 37 CFR 1.132 filed 11/7/03 is insufficient to overcome the rejection of claims 24-43 based upon U.S.C. 103 rejection as set forth in the last Office action because: It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

The Sangret declaration under 37 CFR 1.132 filed 11/7/03 is insufficient to overcome the rejection of claims 24-43 based upon U.S.C. 103 rejection as set forth in the last Office action because: It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Jane Rhee
April 27, 2005



PATRICK JOSEPH RYAN
SUPERVISORY PATENT EXAMINER